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CENTRAL REEXAMINATION UNIT

In re Application of :
Roger Streets et al. :
Application No. 10/664,052 : ORDER TO
Filed: September 16, 2003 : SHOW CAUSE
Attorney Docket No. AOI-73 :
:

This is a show cause order based on the expiration of U.S. Patent No. 6,305,143, for which the present application requests reissue.

BACKGROUND

1. The present application ("present reissue proceeding") was filed March 8, 2002, for reissue of U.S. Patent No. 6,305,143 (the '143 patent), which issued October 23, 2001.
2. On December 14, 2005, in the present reissue proceeding, the examiner issued a non-final office action. In response, on December 14, 2005, a reply was filed.
3. A review of the Office's financial records for the '143 patent reveals that the 3.5 year maintenance fee due and not paid could have been paid during the period from October 23, 2004 through April 25, 2005 (April 23, 2005 was a Saturday), or with a surcharge during the period from April 26, 2005 through October 24, 2005 (October 23, 2005 was a Sunday). As a result, the '143 patent expired after midnight on October 24, 2005, for failure to pay the 3.5 year maintenance fee due. See 1301 *Official Gazette* 87 (December 20, 2005).

ORDER TO SHOW CAUSE

Since the '143 patent has expired for failure to pay the first maintenance fee, the Director of the USPTO no longer has the authority under 35 U.S.C. § 251 to reissue the '143 patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993).

As stated in *Morgan*,

"The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only "for the unexpired part of the term of the original patent." Thus, when Morgan's original patent expired on

August 19, 1992, the Commissioner was divested of his reissue authority because there no longer was an unexpired term of the patent for which Morgan's patent could be reissued. Morgan's appeal thus became moot." [990 F.2d at 1231, 26 USPQ2d at 1393; Emphasis added]

Because the Director no longer has the authority under 35 U.S.C. § 251 to reissue the patent, the Office intends to terminate the present reissue proceeding, and thereafter hold the application for reissue of the '143 patent to be an abandoned application.

CONCLUSION

1. Applicant is hereby being provided with a period of **30 DAYS** from the mailing of this ORDER to show cause why the Office should not terminate the present reissue proceeding. If applicant proposes to show cause why the present reissue proceeding should not be terminated, applicant's showing must include an explanation of why the proceeding should continue in spite of the expiration of the original patent. If applicant makes a showing, the showing will be evaluated as to whether it provides sufficient basis why the present reissue proceeding should not be terminated.
2. Failure to respond to this show cause order within the 30 day period that has been set will result in the proceedings being terminated by default. If the present reissue proceeding is terminated, jurisdiction over the application for reissue of the '143 patent will be returned to Technology Center 3634 for processing as an abandoned application.
3. Jurisdiction over the file for reissue application 10/664,052 is being retained in the Office of Patent Legal Administration (OPLA), pending a response by applicant, or the expiration of time for a response.
4. Telephone inquiries related to this decision should be directed to Fred Silverberg, Senior Legal Advisor, at (571) 272-7719 or, in his absence to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.



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